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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/058,693

01/28/2002

Darryl Richard Schick

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26119

7590

06/16/2004

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EXAMINER

RAHMJOO, MANUCHER

ART UNIT

PAPER NUMBER

2676

10

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/058,693

Applicant(s)

SCHICK ET AL.

Examiner

Mike Rahmjoo

Art Unit

2676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 16-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

Newly submitted claims 16- 31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 16 is directed to formatting and converting a plurality of the images as an album of images which is different than prompting the user to select a plurality of selected images from the group and compressing the image file copies as per citation of claim 1; claim 22 is directed to automatically adjusting image files corresponding to selected images as that the selected images will display in a resolution appropriate for a second display device which is different than receiving an instruction from the user to save the selected images or compressing the image file copies as per recitation of claim 1 ; and claim 29 is directed to automatically eliminating information by down sampling which is different than making a copy of each image file that corresponds to the selected images to result in image file copies as per citation of claim 1.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16- 31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geigel et al (US PUB 2002/0122067), hereinafter, Geigel in view of Mastronardi (US PUB 2002/0126141).

As per claims 1, 6, and 11 Geigel teaches displaying, to a user, a group of images for which corresponding image files are available see for example figure 1 and page 5 paragraph [0077] through the use of album pages; and prompting the user to select a plurality of images from the group see for example page 1 paragraph [0010] for selection based on user preferences; and prompting the user to save the selected as an album of images see for example figure 1 and page 3 paragraph [0056]; and receiving an instruction from the user to save the selected images to the storage medium as an album of images see for example page 5 paragraph [0078]; and making a copy of each image file that corresponds to one of the selected images to result in image file copies see for example page 4 paragraph [0061]; and saving, to the storage medium, the compressed image file copies that correspond to the selected images see for example figure 1 module 56 and page 3 paragraph [0057].

However, Geigel does not teach compressing the image file copies.

Mastronardi teaches compressing the image file copies.

It would have been made obvious to one of ordinary skilled in the art at the time the invention was made to incorporate the teachings to provide bulk memory representing an image and therefore provide a process for making a selecting on a audiovisual reproduction system using user friendly on screen windows see for example page 1 paragraph [0008].

As per claims 2, 7, and 12 Geigel teaches making a contact sheet image (see for example page creator module 126 of figure 7) including a user-selected album title having a font (see for example figures 19- 22 which have alpha numeric labels) and color (see for example page 6 paragraph [0080]) selected by the user, the contact sheet image further including an album tile representations of the one or more images contained in the album see for example page 3 paragraph [0056] where user preferences are applied.

As per claims 3, 8, and 13 Geigel teaches automatically resize the one or more image file copies so that the one or more selected images, when displayed, will have a resolution not exceeding a resolution (system parameters such as resolution for albing situations) required for optimal viewing on a standard display see for example figure 7 and page 4 paragraph [0064] wherein scaling is done through image placement module 132 and page 6 paragraph [0087].

As per claims 4, 9, and 14 Geigel teaches prompting the user to make one or more

modifications to any of the selected images see for example page 1 paragraph [0010] wherein user implements preferences to images; and automatically adjust one or more of the image file copies to include one or more modifications see for example page 3 paragraph [0054] and page 4 paragraphs [0059- 0061] wherein automatic page distribution and duplicate detection is performed; and in the saving step, ensuring that the adjusted image file copies are saved as compressed adjusted image file copies see for example figure 1 and page 3 paragraphs [0056]- [0057] wherein subsequent use of the system by a particular user is done through implementation of user preferences through album automation system and page 4 paragraph [0059] wherein a page layout algorithm must distribute the images amongst a set of pages and then layout the images on each individual page which corresponds to adjusted image file copies as being saved as compressed adjusted image file copies on each individual page.

As per claims 5, and 10 Geigel teaches saving, to the storage medium, a file that contains parameters of the album, wherein the file allows a user to automatically recreate the image album for further duplication or modification see for example figure 1 and page 3 paragraphs [0056]- [0057] wherein implementation of user preferences is done through album automation system which can be repeated by subsequent use of the system and the output can be produced on variety of photo delivery media e.g. picture CD media.

As per claim 15 Geigel saving, to the storage medium, a link that allows a user to view the image files that are stored on the storage medium as an album of images see for example claim 2 on page 12.

### ***Response to Arguments***

Applicant's arguments filed 05/27/2004 have been fully considered but they are not persuasive.

The examiner points out that the claims mentioned on page 9 under "remarks" are 1- 31 instead of 1- 30.

As per applicant's remarks, applicant argues on page 11 that Geigel does not 1)display images and 2)prompt the user to select images to be included in an album from the collection of images that were **input**.

Examiner respectfully disagrees. As per citation made in the office action dated 02/23/2004, Geigel teaches displaying through module 56 of figure 1 and paragraph[0056] wherein an album page can be rendered for displaying, printing or transferring to another medium. Geigel clearly teaches "prompting the user to select images" through **assigning each image object to a page based on user preferences** in paragraph[0010] as per citation made through said office action. However, the "input" language is not found as per citation of the claims. The examiner would suggest amending said feature(s) to further narrow applicant's claimed invention.

Applicant argues on page 11 that Mastronardi "does not teach or suggest the above- cited language from claims 1, 6, and 11.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Piecemeal analysis of the references is not allowed. The secondary art made of the reference is in the same field of endeavor and examiner's is utilizing the reference is to overcome the shortcoming of the primary art made of the reference.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in light of the arguments made above as to "references in the same field of art" the grounds for making use the secondary reference is obviated.

On page 12 line 20 applicant argues the feature which is not taught through the primary art of the reference.

The examiner would respectfully point out to the citation made above from court ruling *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Inquiry**

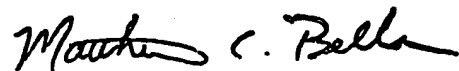
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Rahmjoo whose telephone number is (703) 305-5658. The examiner can normally be reached on 6:30- 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (703) 308- 6829. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872- 9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

Mike Rahmjoo

June 10, 2004



**MATTHEW C. BELLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600**